

### **REMARKS**

The Office Action dated March 25, 2004, has been received and carefully noted. The preceding amendments and the following remarks are submitted as a full and complete response thereto. Claims 4 and 20 have been amended as to matters of form only. Claims 33-53 have been added. Support for the new claims can be found in Figs. 4-6 and the corresponding text of the present specification. No new matter has been added. Accordingly, claims 1-53 are pending in this application and are submitted for consideration.

The Applicants' representative would like to thank the Examiner for taking the time to conduct a personal interview to discuss the outstanding rejections.

Claims 1-32 were rejected under the judicially created doctrine of obviousness-type double patenting over U.S. Patent No. 6,581,341 (the "Baratuci patent"), in view of a secondary reference, U.S. Patent No. 3,891,007 to Kleykamp ("Kleykamp"). Applicants respectfully traverse the rejection and submit that the rejection is improper.

Obviousness type double-patenting is analogous to and evaluated under the same standards as a rejection under 35 U.S.C. § 103. See, MPEP § 804. However, in a double-patenting rejection, the rejected claims are evaluated in view the claims of a granted patent in combination with the prior art. *Id.* Under an obviousness-type double-patenting rejection, the ultimate question is whether the invention defined in a claim at issue is an obvious variation of the invention defined in a claim in a patent. *Id.* Here, the present invention is not an obvious variation of the Baratuci patent claims, and the cited prior art fails to suggest the differences between the prior patent claims

and the present claims.

As Applicants best understand the Examiner's position, the rejection is premised upon replacing the stretchable sealant support member and shim elements of the claims of Baratucci with the corrugated tube of Kleykamp because Kleykamp discloses its tube as being crush-resistant. However, there is no suggestion in Kleykamp that its corrugated tube is adapted for use as (i.e., an obvious variant of) a spacer for use in, e.g., multi-panel window assemblies.

In a double-patenting evaluation, the claims of a patent are compared to the claims of an application in view of the prior art. The specification of the Baratucci patent is not prior art for the purpose of performing the obviousness inquiry, however may be referenced as a dictionary for defining the terms of the claims of the patent. See, MPEP § 804 II (B)(1). Further, the portions of the Baratucci specification which support the claims may be referenced for the purpose of addressing the issue of whether the present claims are an obvious variation of the Baratucci claims. Here, when referring to the supporting sections of the specification, it is clear that the Baratucci claims are quite different from the present invention and it would not have been obvious to substitute a corrugated tube for the spacer in Baratuci.

Claim 1 of Baratuci defines a spacer and sealant assembly comprising: a *stretchable sealant support member* having a planar surface bounded by first and second edges wherein said first and second edges have at least one *pleated portion*; a *shim* having at least one undulating portion in contact with said first and second edges

of said stretchable sealant support member so *that said at least one pleated portion is oriented concavely inward into said at least one undulating portion of said shim to facilitate bending*; and a sealant joined to at least said first and second edges of said sealant support member.

At column 3, lines 24-27 of Baratuci, it states that the spacer assembly 20 includes an undulating strip of rigid material, i.e., a shim 22, and a generally planar strip of rigid material, i.e., a stiffener 24. Baratuci refers to the spacer as "honey combed." Referring to Figs. 1 and 2, the undulations are shown as being about the Z-axis in the X-direction such that the honey-combing provides lateral support from a first glazing 12 to a second glazing 14, which the spacer is in between. "A particularly favorable undulating shim 22 profile includes flat surfaces at the peaks of the undulations which can be adhered to the sealant support member 26 with the stiffener 24 resting or attached to an interior surface of the sealant support member 26 relative to the interior of the window assembly 10." See col. 3, ll. 51-56 of Baratuci. The stiffener 24 is formed on the inside edge of the shim 22 to provide a clean, flat surface in the site-line. A desiccant material 28 may be used on the inside edge to create an improved sight line. See, e.g., Fig. 3A. The pleats are described to be pleats, gussets, crimps or folds that facilitate forming corners. See col. 5, lines 48-57. As shown in Fig. 4, excellent cornering is achieved.

Kleykamp does not describe a window spacer at all and merely describes a corrugated tube. Nothing in the Baratuci patent or in Kleykamp suggests that the

corrugated tube of Kleykamp is an obvious variation on the sealant support member and shim claimed in the Baratuci patent. Further, the corrugated tube of Kleykamp is not adapted to facilitate cornering as is the invention claimed in the Baratuci patent, which includes pleats for facilitating bending the spacer at the corners. Moreover, the corrugated tube of Kleykamp is round and is not adapted to provide an improved sight line in a glazed window assembly, as is the claimed invention of Baratuci. Therefore, one having ordinary skill in the art would not have found it obvious to replace the spacer claimed in the Baratuci patent with a corrugated tube as defined by Kleykamp, in order to derive the present claimed invention. Thus, Applicants submit that the present claims are not an obvious variant of the Baratuci claims in view of the cited prior art, and therefore, the obviousness-type double-patenting rejection is improper. Accordingly, the Applicants request that the rejection of claims 1-32 be withdrawn and claims 1-32 as amended herein be allowed.

Although the Applicant believes that it is unnecessary to amend the claims to differentiate over the cited prior art, new claims 33-53 have been added that include additional features related to the tube portion of the presently claimed spacer. These claims include at least the same limitations as present claim 1 and are therefore patentable for the same reasons as set forth above.

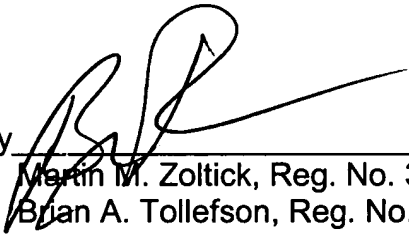
In view of the above, Applicants respectfully submit that the present application is in condition for allowance and requests that claims 1-53 be allowed and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event that this paper is not timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account No. 02-2135.

Respectfully submitted,

By



Martin M. Zoltick, Reg. No. 35,745  
Brian A. Tollefson, Reg. No. 46,338  
Attorney for Applicant  
Rothwell, Figg, Ernst & Manbeck, P.C.  
Suite 800, 1425 K Street, NW  
Washington, D.C. 20005  
Telephone: (202) 783-6040  
Facsimile: (202) 783-6031  
Customer No. 6449